

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA YAMAMOTO,
TOYOHISA SAKURADA and
RYUICHI SAGUCHI

Appeal No. 97-1926
Application No. 07/978,036

HEARD
October 12, 2000

Before Garriss, Lieberman, and Tierney, Administrative Patent Judges.

Lieberman, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 3, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a method for the stabilization of a long-chain unsaturated aliphatic ester, alcohol, ketone or hydrocarbon compound having at least 10 carbon atoms and at least one double bond. The method requires admixing the compound with 2-(2-hydroxy-5-methylphenyl) benzotriazole and a phenolic cc
stabilizer is added in an amount of 0.1 to 10% by weight of the long-chain aliphatic unsaturated compound.

THE CLAIM

Claim 1 is illustrative of appellants' invention and is reproduced below:

1. A method for the stabilization of a long-chain unsaturated aliphatic ester, alcohol, ketone or hydrocarbon compound having at least 10 carbon atoms and at least one double bond in a molecule, which comprises admixing the compound with 2-(2-hydroxy-5-methylphenyl) benzotriazole and a phenolic compound as an antioxidant each in an amount in the range from 0.1 to 10% by weight based on the amount of the long-chain aliphatic unsaturated compound.

THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference.

Ishihara et al.

4,568,771

Feb. 4, 1986

THE REJECTION

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ishihara.

OPINION

We agree with the appellants that the rejection under 35 U.S.C. § 103 is not well founded. Accordingly, we do not sustain this rejection.

The Rejection under 35 U.S.C. § 103

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability," whether on the grounds of anticipation or obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We find that Ishihara discloses a method for stabilizing an aliphatic higher aldehyde compound by admixing the compound with a stabilizer selected from the group consisting of salicylic acid compounds and benzotriazole compounds among others. See column 2, lines 4-22. The stabilizing compounds are present in to 10% by weight of the aldehyde compound. See column 2, lines 22-23. We find that among the compounds disclosed are 2-(2-hydroxy-5-methylphenyl) benzotriazole. See column 2, lines 66-67 and claim 1. We further find that among the compounds exemplified is BHT, i.e., Di-tert-butyl-p-cresol. See Tables 1 and 2.

The basic premise of the rejection is that although Ishihara differs from the claimed subject matter in disclosing the stabilization of a pheromone which just happens to be an aldehyde, one of ordinary skill in the art "having knowledge of the ability of the combination of **BHT** and a

hydroquinone compound to protect an aldehyde pheromone from oxidation, would have sufficient motivation based on knowledge[d] [sic] of the nature of general oxidative reactions (as stated above) to use the same combination to protect pheromones having other oxidative functional groups." See Answer, pages 4 and 5. We disagree.

This premise is not well taken because the examiner has not established by evidence or explanation that long-chain unsaturated aliphatic ester, alcohol, ketone or hydrocarbons are stabilized by the combination of stabilizers utilized by Ishihara of record, or that one of ordinary skill in the art would have had a reasonable expectation that Ishihara's composition would be suitable for that use. The examiner has merely conjectured and speculated that because Ishihara's composition is directed to stabilized higher aliphatic aldehyde compounds it would be considered by one of ordinary skill in the art to be suitable for the stabilization of the claim functional group containing compounds, and such speculation is not sufficient for establishing a prima facie case of obviousness. It is well settled that a rejection based on § 103 must rest upon a factual basis rather than conjecture, or speculation. "Where the legal conclusion [of obviousness] is not supported by the facts i stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); see also In re Sporck, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). Accordingly, we reverse the rejection of claims 1 through 3.

The rejection of claims 1 through 3 under 35 U.S.C. § 103 as being unpatentable over Ishihara is reversed.

PL:tdl

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